

**REMARKS**

The Examiner is thanked for the performance of a thorough search. Claims 1-34 are pending in this application. Applicant respectfully requests reconsideration in view of the amendments made above and the remarks set forth below.

**SUMMARY OF THE REJECTIONS**

Claims 1-3, 13, 16-20, 30, 33 and 34 were rejected under 35 U.S.C. ' 102(e) as being inherent by *Plotnick* (U.S. Provisional Application No. 60/281,037 to Plotnick et al.). Claims 4 and 21 were rejected under 35 U.S.C. ' 103(a) as being unpatentable over *Plotnick* in view of *Sextro* (U.S. Patent Application No. 2002/0040482 A1 to Sextro et al.). Claims 5 and 22 were rejected under 35 U.S.C. ' 103(a) as being unpatentable over *Plotnick* in view of *Gordon* (U.S. Patent No. 6,480,012 B1 to Gordon et al.). Claims 6, 15, 23 and 32 were rejected under 35 U.S.C. ' 103(a) as being unpatentable over *Plotnick* in view of *Zustack* (U.S. Patent Application No. 2002/0087402 A1 to Zustack et al.). Claims 7, 14, 24 and 31 were rejected under 35 U.S.C. ' 103(a) as being unpatentable over *Plotnick* in view of *Chang* (U.S. Patent Application No. 2002/0129362 A1 to Chang et al.). Claims 8 and 25 were rejected under 35 U.S.C. ' 103(a) as being unpatentable over *Plotnick*. Claims 9, 10, 11, 26, 27 and 28 were rejected 35 U.S.C. ' 103(a) as being unpatentable over *Plotnick* in view of *Thomas* (U.S. Patent Application No. 2003/0037068 A1 to Thomas et al.). Claims 12 and 29 were rejected under 35 U.S.C. ' 103(a) as being unpatentable over *Plotnick* in view of *Fudge* (U.S. Patent Application No. 2003/0016302 A1 to Fudge et al.).

**REJECTIONS BASED ON 35 U.S.C. 102(e)**

These rejections are respectfully traversed. Aspects of each of the claims differ from the cited references in notable ways. To distinguish the present invention from the cited references, start by considering differences between Claim 1 and *Plotnick*.

*Plotnick* discloses an overview of personal video recorders as well as proposed methodologies and technologies to enhance the technological and advertising opportunities in

current personal video recorder devices. In particular, the following methodologies and technologies are proposed by *Plotnick*: MPEG splicing and insertion in personal video recorders, personal video recorder storage management using off-line (non-real time) recoding of stored programs to effectively manage storage space, substituting I frames during fast-forwarding or playback sequence, behavioral targeting using structured ad queues, detecting scene cut/change for the purposes of ad insertion, substituting video clips for targeted product placement, playing tailored/targeted “bugs”, on-the-air-fly split screen during credits with targeted ad, advertisement underlays, creating informational buttons for personal video recorder advertisements, tailoring ad length to match the viewer preferences, creating central database of all placed products on all programs, creating personalized viewer profiles, and viewer selected advertisement display and schedule. The personal video recorder in *Plotnick* is defined to be either a stand-alone device or functionality integrated into a television set-top box for digitally recording television programming on a hard disk or other random-access medium. (*Plotnick*, Summary).

Claim 1 is directed toward a method for display of advertising material during personal versatile recorder trick play modes. The method comprises, among other things:

“merging the advertising material with the program material during PVR trick play modes such that the advertising material is displayed during said trick play modes, **wherein the PVR is more than a personal video recorder and has the capability to digitally store and replay analog audiovisual programming and other media types including Internet data files.**” (emphasis added)

It is respectfully submitted that these limitations are not taught, hinted or suggested by *Plotnick*.

It is important to note that the personal video recorder of *Plotnick* is clearly distinguishable from the personal versatile recorder of Claim 1 of the present invention. As the name implies, the personal versatile recorder of Claim 1 is more versatile than the personal video recorder of *Plotnick*.

As stated in *Plotnick*, personal video recorders are based on technologies of digital recording and random access; the use of digital recording on a random-access medium allows the personal video recorder to simultaneously record and playback television programming

(*Plotnick*, page 1). However, a personal video recorder does not have the capability to store and replay other types of media, including Internet data files such as web pages, MP3 files, JPEG files, bitmap files, and the like (Specification, page 2). In addition, a personal video recorder does not have the capability to store, retrieve and replay streamed audiovisual digital programming content from the Internet or other caching servers (Specification, page 2).

In contrast, the method of Claim 1 involves operations on a personal versatile recorder, as opposed to a personal video recorder. The personal versatile recorder recited in Claim 1 has the capability to store and replay other types of media, including Internet data files such as web pages, MP3 files, JPEG files, bitmap files, and the like (Specification, page 2). In addition, the personal versatile recorder of Claim 1 has the capability to store, retrieve and replay streamed audiovisual digital programming content from the Internet or other caching servers (Specification, page 2).

It should be appreciated that although the names “personal video recorder” and “personal versatile recorder” have the same acronym “PVR”, they are not the same devices from a technological standpoint. The personal versatile recorder, as recited in Claim 1, has capabilities that span significantly farther than those of the personal video recorder of *Plotnick*.

For at least these reasons, the method of Claim 1 includes limitations that are not taught, hinted or suggested by *Plotnick*. Thus, it is respectfully requested that the Section 102(e) rejection to Claim 1 be removed.

Independent Claim 18 is the apparatus counterpart to the method of Claim 1. Accordingly, Claim 18 is allowable for similar reasons Claim 1 is allowable. Thus, it is respectfully requested that the Section 102(e) rejection to Claim 18 be removed.

Dependent Claims 13, 16, 17, 30, 33 and 34 are dependent upon base claims that are not taught, hinted or suggested by the cited references. These claims are allowable for similar reasons Claim 1 is allowable. Thus, it is respectfully requested that the Section 102(e) rejection to these dependent claims be removed.

#### **REJECTIONS BASED ON 35 U.S.C. 103(a)**

These rejections are respectfully traversed. None of the cited references, including

*Plotnick, Sextro, Gordon, Zustack, Chang, Thomas, and Fudge*, are directed toward personal versatile recorders. As discussed above, a personal versatile recorder is substantial different from a personal video recorder. Accordingly, none of the cited references teaches, hints or suggests any of the rejected claims. As such, even if the cited references were combined as described in the Office Action, no combination of the cited references would teach, hint or suggest any of the rejected claims.

Further, these Dependent Claims 4-12, 14, 15, 21-29, 31 and 32 are dependent upon base claims that are not taught, hinted or suggested by the cited references. These claims are allowable for similar reasons Claim 1 is allowable. For these reasons, it is respectfully requested that the Section 103(a) rejections to these dependent claims be removed.

**CONCLUSION**

For the reasons set forth above, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Respectfully submitted,

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